

REMARKS

Applicants respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. Claims 1, 2, 6, 9, 17, 19 and 21 have been amended. No claims have been canceled. No claims have been added. Thus, claims 1, 2, 4, 6-24, and 28-35 are pending.

35 U.S.C. §112 Rejections

Rejections under 35 U.S.C. §112, ¶1

In section 5, the Office Action rejects claim 1 under 35 U.S.C. §112, ¶1 for lack of enablement. The Office Action alleges that the specification does not support a functionality for claim 1 reciting “...sending the packet from the first machine to the second machine via the network configuration server...,” and states:

“It is understood by the Examiner that the first machine is in a private network behind a NAT access point, and the second machine is external to the private network. This would require that the communication to be via the NAT access point and not the server that is “external to the private network”

Applicants note that the preamble of claim 1 is amended herein to recite a method to communicate “...via a network address translation (NAT) access point at the first machine....” Regarding the enablement of the actual claim limitation, Applicants respectfully submit that this functionality can be found in the original disclosure at least on page 5, line 21 to page 6, 10 of the specification, which states in a salient portion (emphasis added):

“Consequently, to resolve the application program request for configuration data, a configuration determinator 204 component of the network services 202 contacts an external **network configuration server 210**....

...When the application program embeds the configuration data within application data, a responsive network device (e.g., FIG. 1 H.323 client 116) issues responses that

are sent in accord with the data provided by **server 210**. For example, **assuming the server provided** a network address and communication port of the server, the responsive **network device sends responses to the server; the server then forwards** the response for receipt and usage by the application program 200.”

Accordingly, the original specification provides an enabling description of a server providing configuration data to an application program, and the application communicating with the responsive network device **via the same server**. Furthermore, Applicants respectfully submit that communication via a NAT access point is incidental to the question of enablement for communication via a network configuration server. Applicants simply note that any communication via a network configuration server **does not preclude** that that same communication is **also** via a NAT access point. Absent any other basis for rejection, Applicants submit that the subject matter of currently amended claim 1 is described in the specification in such a way as to enable one of ordinary skill in the art to make and/or use the invention. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶1 rejection of claim 1 be withdrawn.

Rejections under 35 U.S.C. §112, ¶2

In section 6, the Office Action further rejects claim 1 for reciting “without breaking a protocol utilized for communication between the first and second machines.” In rejecting claim 1, the Office Action states that it is unclear how the redirection takes place from the server to the second machine without breaking a protocol. In order to advance prosecution of the claims, Applicants amend claim 1 herein to remove the reference to “breaking a protocol utilized for communication between the first and second machines.” The preamble of claim 1 is also amended herein to recite a method to communicate “via a network address translation (NAT) access point at the first machine....” These amendments to claim 1 render moot the basis for the above rejection offered in the Office Action. Applicants submit that currently amended claim 1 points out and distinctly claims the subject matter which Applicants regard as the invention. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 1 be withdrawn.

In section 7, the Office Action further rejects claim 1 for reciting “...sending the packet from the first machine to the second machine via the network configuration server...” The Office Action states that it is unclear how the first machine sends packets through the network configuration server and not a NAT access point. As with the previously-discussed 35 U.S.C. §112, ¶1 rejection of claim 1, Applicants note that the preamble of claim 1 is amended herein to recite a method to communicate “...via a network address translation (NAT) access point at the first machine....” These claim amendments render moot the basis for the above rejection which was offered by the Office Action. Furthermore, Applicants again note that any communication via a network configuration server **does not preclude** that that same communication is **also** via a NAT access point. One does not speak to the definiteness of the other, in this context. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 1 be withdrawn.

In section 8, the Office Action further rejects claim 1 for reciting “receiving network configuration data that is not subject to NAT.” More particularly, the Office Action alleges that the scope of the limitation is unclear. Applicants amend claim 1 herein to remove the relevant limitation “that is not subject to NAT.” Claim 1 is further amended herein to recite (emphasis added):

“...receiving at the first machine network **configuration data** from a network configuration server external to the private network;...
embedding the received network configuration data...in a data portion of a packet...
sending the packet...the **sending without subjecting the embedded configuration data to NAT** by the NAT access point at the first machine.”

Currently amended claim 1 does not refer to “network configuration data that is not subject to NAT,” thereby rendering moot the basis for the above rejection offered in the Office Action. Applicants submit that currently amended claim 1 points out and distinctly claims the subject matter which Applicants regard as the invention. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 1 be withdrawn.

In section 9, the Office Action further rejects claim 1, citing various reasons related to the point of the claim limitations and how certain claim limitations are practiced. More particularly, the Office Action cites the claim limitation “sending the packet...based at least in part on the network configuration data and the destination address.” Applicants note that claim 1 is amended herein to recite in a salient portion (emphasis added):

“...embedding the received network configuration data and a destination address associated with the second machine in a data portion of a packet, **the embedded configuration data implementing in part the network configuration server as a proxy server for the first machine;**

sending the packet from the first machine to the second machine via the network configuration server based at least in part on the network configuration data and the destination address, the **sending without subjecting the embedded configuration data to NAT** by the NAT access point at the first machine.”

Applicants submit that claim 1 as amended particularly points out and distinctly claims the subject matter which Applicants regard as the invention.

The Office Action states (emphasis added):

“It is unclear **what the point is** of the server sending the configuration data to the first machine in the first place if all the first machine does is send it directly back to the server.”

To the extent that it may be applied to claim 1 as currently amended, Applicants respectfully submit that this is an improper basis for a 35 U.S.C. §112, ¶2 rejection. More particularly, the Office Action improperly extends a definiteness requirement to include a requirement that the claim include the purpose of the invention. The Office Action does not set forth where this is a requirement under 35 U.S.C. §112, ¶2, and Applicants are not familiar with such are requirement.

The Office Action further states (emphasis added):

“The phrase ‘based at least in part on the network configuration data and the destination address’ does not explain **how** the configuration data is used or **why** it would be based on the configuration data to send the configuration data in the data portion no less. The phrase is unclear as to **how** the sending is based on the destination address since the destination address is in the data portion of the data

packet. The claim does not say it is in the header of the packet, and it is therefore unclear as to **how** to base the sending on the destination address.

To the extent that it may be applied to claim 1 as currently amended, Applicants further submit that this argument is an improper basis for a 35 U.S.C. §112, ¶2 rejection. The Office Action does not allege that any part of “sending the packet from the first machine to the second machine via the network configuration server” is, for example, ambiguous, confusing, vague, etc. Rather, the Office Action inquires into **how** and/or **why** parts of the method are to be performed in practicing the invention. The Office Action does not indicate how these inquiries fall within the analysis for determining definiteness under 35 U.S.C. §112, ¶2, and Applicants believe they do not. Furthermore, these inquiries as to **how** and/or **why** parts of the claimed method are performed presuppose that **what** is performed, as recited in the claims, is particularly pointed out and distinctly claimed.

The Office Action further states (emphasis added):

“There does not appear to be any association between the network configuration data and the second machine. In regards to the claimed invention, Examiner does not see a reason to have the configuration data since it has no functional interrelationship with anything else in the claim.”

Applicants simply note that amended claim 1 states in a salient portion:

“...the embedded configuration data **implementing in part** the network configuration server as a **proxy server** for the first machine;...”

Applicants submit that currently amended claim 1 recites a functional interrelationship of the claim elements, and particularly points out and distinctly claims that which the Applicants regard as their invention. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 1 be withdrawn.

In section 10, the Office Action further rejects claim 1 under 35 U.S.C. §112, ¶2 “as being incomplete for omitting essential steps”, citing M.P.E.P. §2172.01. M.P.E.P. §2172.01 states in a salient portion (emphasis added):

“A claim which **omits matter disclosed to be essential to the invention as described in the specification or in other statements of record** may be rejected under 35

U.S.C. 112, **first paragraph**, as not enabling. In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976)."

M.P.E.P. §2172.01 makes no other reference to rejections based on omitted matter. Therefore, the Office Action improperly rejects claim 1 under the **second** paragraph of 35 U.S.C. §112, while citing a passage in the M.P.E.P. dealing with rejections under the **first** paragraph of 35 U.S.C. §112. Therefore, the rejection is offered on an improper basis to which Applicants cannot respond. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 1 be withdrawn.

In order to advance prosecution, Applicants note that some of the alleged "essential steps" are not steps at all, and that the Office Action is inquiring into **how** technical details beyond the scope of the claim are to be implemented. Furthermore, the Office Action fails to offer any support as to how any one of the above cited arguments relates to "matter disclosed to be essential to the invention as described in the specification or in other statements of record."

In section 11, the Office Action rejects claim 2 for reciting "...for receiving network traffic sent to the network address." Claim 2 is amended to recite (emphasis added):

"...establishing a tunnel between the first machine and the network configuration server **for relaying to the first machine** network traffic sent to the network address."

Applicants submit that the claim as amended particularly points out and distinctly claims the subject matter which Applicants regard as their invention. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 2 be withdrawn.

In section 12, the Office Action further rejects claim 6, alleging that there is no functional interrelationship between the claim limitations.

Applicants amend claim 6 herein to recite in a salient portion (emphasis added):

"...transmitting **from the first network** a second request for a second address on the second network, the second request in response to a first request for a first address of a first machine on the first network;

in response to the second request, sending to the first network the second address from a server on the second network;”

Applicants submit that the claims as amended recite the functional interrelationship between the claim limitations. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 6 be withdrawn.

In section 13, the Office Action further rejects claim 6 for reciting, alleging that it is unclear how using a network address provides a network configuration. Claim 6 is amended herein to recite in a salient portion:

“...using the second network address in the payload of the packet at the server **as a network configuration** for a communications exchange.”

Applicants respectfully submit that using a network address **as a network configuration** is clear for the purposes of the definiteness requirement. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 6 be withdrawn.

In section 14, the Office Action further rejects claim 6, alleging that it is unclear as to what is “using the second network address.” Claim 6 is amended herein to recite in a salient portion:

“...using the second network address in the payload of the packet **at the server** as a network configuration for a communications exchange.”

Applicants respectfully submit that reciting using a second network address **at the server** as a network configuration is clear for the purposes of the definiteness requirement. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 6 be withdrawn.

In section 15, the Office Action rejects claim 17, alleging that it is unclear as to what is “allocating an external address on an external network.” Claim 17 is amended herein to recite in a salient portion (emphasis added):

“...allocating **at the external server** an external address on an external network;...”

Applicants respectfully submit that allocating at the external server an external address is clear, for the purposes of the definiteness requirement. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 17 be withdrawn.

In section 16, the Office Action further rejects claim 17 for reciting, alleging that it is unclear as to what is “providing the external address.” Claim 17 is amended herein to recite in a salient portion (emphasis added):

“**...sending the external address from the external server to the network driver of the first machine ...”**

Applicants respectfully submit that sending the external address from the external server is clear, for the purposes of the definiteness requirement. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 17 be withdrawn.

In section 17, the Office Action rejects claim 21 for reciting, alleging that it is “unclear where these method steps are performed.” Claim 21 is amended herein to recite in a salient portion (emphasis added):

“**...providing at the first machine layer-based network services...;**
executing at the first machine an application program...;
providing a WAN address to said application program ..., the providing by the layer-based network services of the first machine;...”

Applicants respectfully submit that the limitations recited in amended claim 21 are clear, for the purposes of the definiteness requirement. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 21 be withdrawn.

In section 18, the Office Action further rejects claim 28 for reciting “performing network address translation (NAT) on the packet by the access point of the packet origin.” However, the Office Action states “It is unclear to the Examiner”, without setting forth any description as to what is unclear, or providing any other basis for the rejection to which Applicants may respond. Applicants submit that claim 28 is clear for the purposes of the definiteness requirement. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §112, ¶2 rejection of claim 28 be withdrawn. Furthermore, Applicants

request that any subsequent Office Action which includes a claim rejection related to the above rejection (1) be non-final, and (2) provide a basis for rejection to which Applicants may respond.

35 U.S.C. §103(a) Rejections

35 U.S.C. §103(a) Rejection over Zhang and Molitor

In sections 19-21, the Office Action rejects claim 1, 2, 4, 6-24, and 28-35 under 35 U.S.C. §103(a) as being obvious in light of Zhang et al., USPN 6,381,646 (*Zhang*) in view of Molitor, USPN 6,661,799 (*Molitor*). The Office Action states:

“21. *Zhang* and *Molitor* were applied for claims’ rejection, cited in the previous Office Action, which are applicable, hereby incorporated by reference.”

Applicants note that the Office Action is in response to Applicant’s communication filed on October 3, 2006, which in turn was in response to the previous Office Action mailed February 27, 2006. Applicants further note that the Office Action of February 27, 2006 does not reject any claims based on any combination of *Zhang* and *Molitor*. Furthermore, previous rejections under *Zhang* and *Molitor* were the subject of an appeal from which a decision in Applicants’ favor was mailed on December 16, 2005.

For at least the foregoing reasons, the Office Action fails to properly cite a basis for an obviousness rejection to which Applicants respond. Applicants respectfully submit that *Zhang* and *Molitor* have already been overcome on appeal, and ask that the above 35 U.S.C. §103(a) rejection of claim 1, 2, 4, 6-24, and 28-35 based on *Zhang* and *Molitor* be withdrawn. Furthermore, Applicants request that any subsequent claim rejection based on *Zhang* and/or *Molitor* be in an Office Action which (1) is non-final, and (2) provides a basis for rejection to which Applicants may respond.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 1, 2, 4, 6-24, and 28-35 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,
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